REMARKS

FORMAL MATTERS:

Claims 16-18, 22-26, 40-44, 46-50, 57-63 and 65-68 are pending and currently under examination.

Claims 16-18, 22-26, 40-44, 46-50, 57-63 and 65-68 were rejected.

No new matter has been added.

WITHDRAWN REJECTIONS

Applicants thank the Examiner for indicating that the prior rejection under 35 U.S.C. §102(b) over Crabtree et al. (WO 95/02684) has been withdrawn.

COMMUNICATION REGARDING CO-PENDING APPLICATION

In compliance with the Applicants' duty to disclose under 37 C.F.R. §§1.56 and 1.2, as discussed in *McKesson Info. Soln. Inc., v. Bridge Medical Inc.*, 487 F.3d 897; 82 USPQ2d 1865 (Fed. Cir. 2007), Applicants wish to make the Examiner aware of co-pending application 11/011,776, filed December 13, 2004.

This document is available on PAIR, and thus is not provided with this communication.

CLAIMS REJECTIONS – 35 U.S.C. § 102(e)

Claims 16-18, 22-26, 40-44, 46-50, 57-63 and 65-68 were rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Briesewitz et al. (U.S. Patent 6,372,712) ("'712 patent"). Applicants respectfully traverse the rejection.

Applicants enclose herewith a Declaration by all three inventors of the instant application.[1] In view of this Declaration, it is believed that the above rejection may be withdrawn. In particular the declaration states, *inter alia*:

> In contrast to the composition of matter claims of U.S. Patent No. 6,372,712, the claims of the above-captioned application are directed to a particular use of bifunctional molecules, i.e., methods of directing the biodistribution of a drug that binds to a protein target. To the extent that this particular application is disclosed in the specification of U.S. Patent No. 6,372,712 (if at all), this particular applications was not conceived by either of Gregory Ray or Kurt Vogel.

Applicants submit that the '712 patent is not prior art to the instant application under §102(e) because the '712 patent is not the earlier work of another; it is the work of the co-inventors of the instant application. As such, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 6-18, 22-26, 40-44, 46-50, 57-63 and 65-68 under 35 U.S.C. § 102(e) as allegedly being anticipated by the '712 patent.

Claims 16-18, 22-26, 40-44, 46-50, 57-63 and 65-68 were rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Briesewitz et al. (U.S. Patent 6,921,531) ("'531 patent"). Applicants respectfully traverse the rejection.

In view of the enclosed Declaration, it is believed that the above rejection may be withdrawn. In particular the declaration states, *inter alia*:

> In contrast to the method claims of U.S. Patent No. 6,921,531, the claims of the above-captioned application are directed to a different use of bifunctional molecules, i.e., methods of directing the biodistribution of a drug that binds to a protein target. To the extent that this particular application was disclosed in the specification of U.S. Patent No.

[1] Dr. Crabtree was temporarily unavailable to sign the attached Declaration. As such, the attached Declaration is included without Dr. Crabtree's signature. A copy of the declaration with Dr. Crabtree's signature will be submitted to the Office once received.

6,921,531 (if at all), this particular application was not conceived by either of Gregory Ray or Kurt Vogel.

Applicants respectfully submit that the '531 patent is not prior art to the instant application under §102(e) because the '531 patent is not the earlier work of another; it is the work of the co-inventors of the instant application. As such, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 6-18, 22-26, 40-44, 46-50, 57-63 and 65-68 under 35 U.S.C. § 102(e) as allegedly being anticipated by the '531 patent.

CLAIMS REJECTIONS – NON-STATUTORY OBVIOUSNESS-TYPE DOUBLE PATENTING

Claims 16-18, 22-26, 40-44, 46-50, 57-63 and 65-68 were rejected on the ground of non-statutory obviousness-type double patenting over claims 1-4, 6-10 and 12-19 of the '531 patent.

The Applicants categorically disagree with these rejections. However, solely to expedite prosecution of the instant application, the Applicants provide herewith a Terminal Disclaimer over U.S. Patent No. 6,921,531.

The Applicants note that the filing of a Terminal Disclaimer to obviate a rejection based on non-statutory double patenting is not an admission of the propriety of the rejection.[2] As such, while the Applicants firmly believe that this rejection fails to meet the requirements for Obviousness-Type Double Patenting set forth in MPEP § 804, a Terminal Disclaimer is nevertheless filed.

Accordingly, in view of terminal disclaimer filed herewith, the Applicants respectfully request that this rejection be withdrawn.

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[2] *Quad Environmental Technologies Corp. v. Union Sanitary District*, 946 F.2d 870, 20 USPQ2d 1392 (Fed. Cir. 1991). The court indicated that the "filing of a terminal disclaimer simply serves the statutory function of removing the rejection of double patenting, and raises neither a presumption nor estoppel on the merits of the rejection."

CONCLUSION

Applicants submit that all of the claims are in condition for allowance, which action is requested. If the Examiner finds that a telephone conference would expedite the prosecution of this application, please telephone the undersigned at the number provided.

The Commissioner is hereby authorized to charge any underpayment of fees associated with this communication, including any necessary fees for extensions of time, or credit any overpayment to Deposit Account No. 50-0815, order number STAN-131.

Respectfully submitted,
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